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10/085,196	02/27/2002	Sunil V. Thakur	SUNI	1473

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EXAMINER

LE, KHANH H

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,196

Applicant(s)

THAKUR ET AL.

Examiner

Khanh H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

1. This Office Action is responsive to the Response dated Dec. 09, 2004. Amended claim 8 and new claims 12-13 have been entered. Claims 1-13 are presented for examination.

Previous Objections to Specifications

2. Withdrawn per the amended specifications.

Previous Claims Objections

3. As to claim 8: withdrawn.

Response to Arguments

4. Applicants' arguments have been carefully considered but deemed unpersuasive. Williams was used for the sole purpose of teaching that coupons may be provided (downloaded) to a user's system automatically (without the consumer's knowledge) or on demand. Thus it was earlier stated that "It would have been obvious to one skilled in the art at the time the invention was made to add Williams to Kepecs because both references deal with coupons and the automatic download thereof is an art recognized equivalent for delivering coupons on demand ...".

Kepecs already teaches automatic applying of the discounts once the discounts are provided to the customer's account. In Kepecs the customer selects the discounts. As presented

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above, Williams further teaches that discounts can also be provided without the customer's awareness in addition to selection by the customer. Once provided, either by customer selection or indiscriminately to the customer's account as taught by Williams the method of Kepecs works to automatically apply the discounts once the discounted purchases are made, regardless of the customer's awareness. Thus the Kepecs/Williams system meet at least Applicants' independent claims as presented below.

(Please also note that automatic applying of discounts to purchases at POS's without customer awareness of the discounts is known before Applicants' filing date as shown by the art cited in the conclusion section below).

Further, contrary to argument, as to claim 10, Kepecs discloses transmitting signal to the vendor to cause a discount to such items purchased by the consumer and, as to claim 11, it discloses a host system that applies a discount on an itemized basis for the benefit of the consumer (see at least col. 10 lines 59-64).

The arguments as to Hoffman are unpersuasive as Kepecs teaches automatic applying of discounts to transactions once the discounts are made available to the customers, and Williams teaches the availability can be effected either upon customer demand or automatically without it.

The following is a repeat of the last Office Action with minor modifications in **bold**.

Claim rejections. 35 U.S.C. 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claims 1-4, 7-8, 10 -13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kepecs, US 6009411 hereinafter Kepecs in view of Williams**

US 6075971, herein Williams.

Kepecs generally discloses a method and system for distributing and redeeming electronic promotions to a consumer through the Internet is provided. An account which is associated with a unique key is maintained for each consumer account. Access is permitted to the consumer account upon presentation of the unique key over the internet. The consumer is presented discount or other promotional choices of items available in at least one store associated with the key, or a collection of such stores, over the Internet and the selections of the discount or promotional choices made by the consumer over the internet are recorded. Upon purchase of items at the associated store by the consumer, such data are received, and the selections and purchases are reconciled to record a credit in the customer account. No consumer action other than the selection of promotions desired is required for item purchase.

Thus as to claims 1, 2, 8,10,11, Kepecs discloses:

A business system (Figs 1,2,3 and associated text) comprising a magnetic strip card with consumer identifying information encoded thereon, said information identifying a consumer desiring to conduct a transaction with a vendor (see at least col 7 l. 27 –38; **col. 10 lines 19-67**);

a host system remote from the vendor location that maintains information about said vendor, (Fig 1-3 and associated text, especially DAP; see at least col 3 l. 30 et seq. ; col 7 l. 60 et seq. to col. 10 l. 67)

an apparatus for reading the consumer identifying information on the magnetic said apparatus interconnected with and in communication with the host system for ascertaining any applicable discounts of said discounts (see at least Fig 2 and associated text, especially ATM, UPC, (see at least col. 4 l. 48-67, **col. 10 lines 19-67**), and

means apart from the magnetic strip card (e.g. the DAP in Kepecs) for applying any applicable discount of said discounts related to said transaction for the benefit of said consumer (see at least Fig 1-3 and associated text, cols 3-10; col 11 l. 1-21 and 45-55 to col 12 l. 50; **col.10 lines 19-67**)

means at the host system for receiving from the vendor transaction information about said transaction, and means at the host system for storing said information. (figs 2 and 3 and accompanying text; col 10 l. 59-col 13 l. 22).

Kepecs does not disclose applying the discount without a selection from the consumer of any said applicable discount, and without requiring consumer awareness of any said applicable discount.

However, Williams discloses a method and apparatus for providing and monitoring coupons via a network wherein coupons may be downloaded to a user's system automatically or on demand **via the internet (see at least abstract)**.

It would have been obvious to one skilled in the art at the time the invention was made to add Williams to Kepecs because both references deal with coupons and the automatic download thereof is an art recognized equivalent for delivering coupons on demand as taught by Williams.

Claim 3. Kepecs discloses the system of claim 1. Further Kepecs at least suggests means for calculating a future discount for the consumer based on the transaction information. (See col 8 l. 12-46: targeting individual consumers based on past purchase histories)

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Claim 4. Kepecs discloses the system of claim 3 thus implicitly discloses means for providing the consumer with information about the future discount (see claim 3 above) .

Claim 7. The system of claim 1 is disclosed as above. Further, Kepecs does disclose using the internet to contact the host system (fig 1 and associated text).

As to claim 12 (dependent on claim 11), Kepecs further discloses connecting in an initial split connection the point-of-sale terminal to a host system for communication therewith, the database of discounts, maintained in the host system, the host system remote from the point-of-sale terminal (see at least col. 10 lines 19-67)

the host system accomplishing said determining, and

the host system accomplishing said transmitting (see at least col. 10 lines 19-67).

As to claim 13 (dependent on claim 12), Kepecs further discloses , following said determining and said transmitting, completing the purchase via a payment processing system (see at least col. 10 lines 19-67).

7. Claims 5-6 and 9 are rejected under 35 USC 103(a) as unpatentable over Kepecs in view of Williams as applied to claim 3 above and further in view of Hoffman US 5297026.

Claims 5 and 6 .

As per claims 5-6 (dependent on claim 3), Kepecs does not disclose means for calculating an amount to a retirement account contribution for a consumer based on the transaction information (claim 5) or based on the calculated amount (Claim 6).

However, Hoffman US 5297026 disclose giving rewards for purchases in the form of a percentage of the amount spent (claim 6) deposited in a customer account earning interest

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at a higher rate (abstract). Thus one skilled in the incentives arts would have known from Hoffman's teachings regarding the use of such incentives accounts to include retirement accounts such as to lure naive aging baby boomers to spend more. As to the basis of such reward being the nature of the transaction (claim 5) such marketing technique is well-known and obvious (e.g. use MasterCard, earn more rewards; buy particular product, earn more).

As to claim 9, Kepecs discloses means for determining a pertinent geographical area for the consumer (col 9 1. 2-5; col 7 1. 60- col 8 1. 22.; col 9 1. 30 et seq *"the consumer selects the desired discounts, and if required, at which stores"*; geographic limitations and sellers information) means for automatically determining the pertinent geographic area based on information about a consumer (col 11 1. 4-10 : the computer infers customer likely store selection from his purchasing history). Hoffman further discloses the additional features as explained in claims 5 and 6 for the same motivation.

Conclusion

8. Prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Valencia, US 5380991 discloses consumer smart card w/ discounts amounts loaded thereon, list of coupons at main computer, scanning of purchased items, automatic application of the coupons when the proper items are bought (see at least col. 3 lines 13-33). The customer coupon cards' purpose is to keep customer purchase history for progressive discounts and keep track of a maximum amount of discounts allowed.

*Pruchnicki, U.S. Pat. No. 5,185,695 discloses an electronic coupon list which includes product type, validation period and discount amount maintained in memory. When products on the coupon list are purchased, the discount is automatically deducted from the purchase price. Consumers who purchase the goods when visiting the store without prior knowledge of the discount, still get the discounts.

* cited in IDS

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 703-305-0571. The Examiner works a part-time schedule and can best be reached on Tuesday-Wednesday 9:00-6:00. The examiner can also be reached at the e-mail address: khanh.le2@uspto.gov. (However, Applicants are cautioned that confidentiality of email communications cannot be assured.)

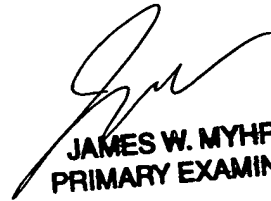
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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 703-305-8469. (After our Art Unit moves to the Alexandria campus, sometime during or after April 2005, the Examiner's phone number will be 571-272-6721 and Mr. Eric Stamber's will be 571-272-6724. The current numbers are still in service until the move). The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

February 15, 2005

KHL



JAMES W. MYHRE
PRIMARY EXAMINER